

Attorney Docket No.: DEX-0192
Inventors: Ali et al.
Serial No.: 09/807,200
Filing Date: May 29, 2001
Page 4

REMARKS

Claims 1 and 6 are pending in the instant application. Claims 1 and 6 have been rejected. Claim 1 has been amended. Claim 6 has been canceled without prejudice. Support for these amendments can be found in the specification at page 6, lines 23-24, page 7, lines 21-27, page 8, lines 23-30 and Example 2 beginning at page 18. Thus, no new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Objection to Claims 1 and 6

Claims 1 and 6 have been objected to as being drawn, in part, to a non-elected invention, namely diagnosing the presence of prostate cancer comprising measuring the protein level of SEQ ID NO:2.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to delete any reference to non-elected subject matter and to include the phrase "or a nucleic acid which encodes a protein of SEQ ID NO:2". Support for this amendment is provided in the specification at page 6, lines 23-24. Claim 6 has been canceled without prejudice in light of the amendments to claim 1.

Attorney Docket No.: DEX-0192
Inventors: Ali et al.
Serial No.: 09/807,200
Filing Date: May 29, 2001
Page 5

Withdrawal of this objection is therefore respectfully requested.

II. Rejection of Claims 1 and 6 under 35 U.S.C. § 112, first paragraph - Lack of Enablement and Scope

Claims 1 and 6 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner suggests that the specification does not disclose or define what "relevant" tissues are.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have deleted the phrase "relevant" from claim 1. Claim 6 has been canceled without prejudice. Further, in the amendment filed by Applicants on June 18, 2003, Applicants addressed the Examiner's further concerns regarding scope of this claim by replacing the term "change" with --increase--. Claim 1, as now presented thus removes all language which the Examiner has suggested to be not enabled.

Withdrawal of these rejections under 35 U.S.C. § 112, first paragraph, is respectfully requested in light of the amendments to the claims.

III. Rejection of Claims 1 and 6 under 35 U.S.C. § 112, second

Attorney Docket No.: DEX-0192
Inventors: Ali et al.
Serial No.: 09/807,200
Filing Date: May 29, 2001
Page 6

paragraph

Claims 1 and 6 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner suggests that the language "relevant" in claim 1 is indefinite. As discussed in Section II, *supra*, this language has been removed from claim 1. Claim 6 has been canceled without prejudice. As the amendment to the claims removes all language suggested to be indefinite by the Examiner, withdrawal of this rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

IV. Rejection of Claims 1 and 6 under 35 U.S.C. § 102(e)

Claims 1 and 6 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,177,244, as evidenced by U.S. Patent 6,287,777. Arguments presented previously by Applicants were found unconvincing as the limitation of "2-fold increase" was not placed in the claims and not supported by teachings at page 19, lines 21-27 of the specification.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claim 1 to include the limitation "at least two times higher" with respect to levels of

Attorney Docket No.: DEX-0192
Inventors: Ali et al.
Serial No.: 09/807,200
Filing Date: May 29, 2001
Page 7

SEQ ID NO:1 or a nucleic acid which encodes a protein of SEQ ID NO:2 in a patient compared to human controls which are indicative of prostate cancer. Support for this amendment can be found in the specification page 7, lines 21-27 and page 8, lines 23-30 as well as in the data presented in Table 2 at page 21-24 of the specification wherein the majority of prostate cancer samples are shown to have levels of SEQ ID NO:1 at least two times higher than normal adjacent tissue. This amendment clearly distinguishes the present invention from prior art teachings such as U.S. Patent 6,177,224 and U.S. Patent 6,287,777 which provide no teaching whatsoever of what degree of expression is indicative of prostate cancer.

Withdrawal of this rejection under 35 U.S.C. § 102(e) is therefore respectfully requested.

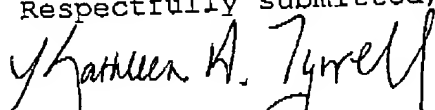
V. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record.

Attorney Docket No.: DEX-0192
Inventors: Ali et al.
Serial No.: 09/807,200
Filing Date: May 29, 2001
Page 8

Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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